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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/701,265

11/04/2003

Brenda F. Baker

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EXAMINER

PITRAK, JENNIFER S

ART UNIT

PAPER NUMBER

1635

MAIL DATE

DELIVERY MODE

10/31/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/701,265	<b>Applicant(s)</b> BAKER ET AL.	
	<b>Examiner</b> JENNIFER PITRAK	<b>Art Unit</b> 1635	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 09 July 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 120,121,124-128,131-133,136-154 and 157-167 is/are pending in the application.
- 4a) Of the above claim(s) See Continuation Sheet is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 120,121,124-128,131-133,136-154 and 157-167 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

Continuation of Disposition of Claims: Claims withdrawn from consideration are 125,126,128,131-133,141,142,144-147,150-154 and 157-167.

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## **DETAILED ACTION**

### ***Remarks***

In the response filed 07/09/2008, Applicant canceled claims 122, 123, 129, 130, 134, 135, 155, and 156 and amended claim 120. Claims 125, 126, 128, 131-133, 141, 142, 144-147, 150-154, and 157-167 are withdrawn from consideration because they are directed to non-elected subject matter. Claims 120, 121, 124, 127, 136-140, 143, 148, and 149 are under examination.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

### ***Priority***

Applicant's claim for the benefit of a prior-filed application under 35 U.S.C. 119(e) or under 35 U.S.C. 120, 121, or 365(c) is acknowledged and granted in view of applicant's arguments filed 01/09/08. Therefore, the instant claims are afforded the benefit of application 08/870,608, filed 06/06/97.

### ***Claim Objections – withdrawn***

The objection to claim 122 is moot because the claim has been canceled.

***Claim Rejections - 35 USC § 112 – withdrawn***

The rejection of claims 120-124, 127, and 136-138 under 35 USC § 112 first paragraph has been obviated by the amendments to the claims. Therefore, the rejection is withdrawn.

***Claim Rejections - 35 USC § 102 - withdrawn***

The rejection of claims 120, 121, 124, 127, and 136-138 under 35 U.S.C. 102(b) as being clearly anticipated by Crooke (2000, U.S. Patent 6,107,094) is withdrawn in view of applicant's arguments filed 01/09/08.

***Claim Rejections - 35 USC § 103 - withdrawn***

The rejection of claims under 35 U.S.C. 103(a) as being unpatentable over Crooke (2000) and Elbashir, *et al.* (2001) has been obviated by the amendments to the claims. Therefore, the rejection is withdrawn.

***Double Patenting - maintained***

Claims 139, 140, 143, 148, and 149 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 4, 7, and 8 of U.S. Patent No. 6,107,094 ('094) and over claim 29 of U.S. Patent 5,898,031. This rejection is maintained for the reasons of record.

***Double Patenting - new***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible

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harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 120, 121, 124, 127, 136-138 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 333-359 of copending Application No. 09/479,783. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of application 09/479,783 are to compositions comprising duplexes that are of the same size (17-25 nucleotides), that comprise the same modifications (2' fluoro and 2'-OCH<sub>3</sub>), and are gapmers just as are the instant claims. The limitations of at least a 4-nucleoside gap and of two- to seven-nucleoside wings are not claimed in the '783 application, but are taught by the specification (see figure 1). Thus, the instant claims are obvious over those of Application No. 09/479,783.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

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***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JENNIFER PITRAK whose telephone number is (571)270-3061. The examiner can normally be reached on Monday-Friday, 8:30AM-5:00PM, EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James (Doug) Schultz can be reached on 571-272-0763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Jennifer Pitrak  
Examiner  
Art Unit 1635

/Tracy Vivlemore/  
Primary Examiner, Art Unit 1635